

REMARKS

I. Domestic Priority

In the Office Action, no acknowledgement was made of Applicants' claim for domestic priority under 35 U.S.C. § 119(e). The instant application claims the benefit of priority of U.S. Provisional Patent Application No. 60/198,319, filed April 19, 2000. Applicants respectfully request acknowledgement of domestic priority in the next communication.

II. References of Record

In the Office Action, U.S. Patent No. 4,101,872 to Pappas was applied in claim rejections under 35 U.S.C. § 103(a). However, the Pappas reference was not made of record in this application by citation on a PTO-892 form (Notice of References Cited). Applicants respectfully request that a PTO-892 form citing the Pappas reference be provided with the next communication.

III. Objections to the Specification

In the Office Action it was stated that claims 52-57 have been renumbered as 53-58, respectively. Applicants acknowledge the renumbering of those claims. Any subsequent reference to claims 53-58 refers to the claims as renumbered by the Examiner.

In addition, claim 54 was objected to because the claim dependency was allegedly not clear. By this Amendment, the dependencies of claims 53-58 have been corrected, thereby rendering the objection moot. Accordingly, Applicants respectfully submit that the objection should be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

IV. Status of the Claims

Claims 1-27 and 41-58 are pending. By this Amendment, claims 18, 23, 24, and 52-58 have been amended without limiting or narrowing their scope to correct minor typographical errors.

V. Claim Rejections Under 35 U.S.C. § 103

In the Office Action, claims 1, 7, 8, 18-27, 41-43, 49, and 52-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,713,491 to Grabowski et al. (Grabowski) in view of U.S. Patent No. 4,058,167 to Granek et al. (Granek). Further, claims 2-6 and 44-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grabowski in view of Granek and further in view of U.S. Patent No. 4,101,872 to Pappas. Claims 14-17, 20-22, 51, and 54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grabowski, Granek, and Pappas and further in view U.S. Patent No. 6,032,745 to Sears. In addition, claims 9 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grabowski in view of Granek and further in view of U.S. Patent No. 3,909,814 to Eguchi. Finally, claims 10-13, 23, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grabowski, Granek, and Eguchi and further in view of U.S. Patent No. 4,987,958 to Fierbaugh. These rejections are respectfully traversed based on the following comments.

A. Claims 1, 7, 8, 18-27, 41-43, 49, and 52-58 are patentable over Grabowski in view of Granek

To establish a prima facie case of obviousness under 35 U.S.C. § 103, three basic criteria must be satisfied. First, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify a reference or to combine reference teachings.”

M.P.E.P. § 2143. “Second, there must be a reasonable expectation of success.” *Id.*

Third, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *Id.*

There are three possible sources for finding “motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons skilled in the art.” M.P.E.P. § 2143.01 (quoting *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998)). Moreover, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” M.P.E.P. § 2143 (citing *In re Vaeck*, 947 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Under the guidance of the M.P.E.P., an obviousness rejection relying on the combination of the Grabowski reference with the Granek reference fails to establish a prima facie case of obviousness because there is no suggestion or motivation to combine the subject matter of these references. Rather, the rejection appears to rely on hindsight and the teaching of Applicants’ own disclosure to find the motivation needed to combine the cited references.

Further, even if the reference teachings of Grabowski and Granek were combined, the combined teachings fail to teach or suggest Applicants’ claimed combination recited in independent claims 1, 18, 41, 43, and 52. Accordingly, Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

1. There is no suggestion or motivation to combine the teachings of Grabowski and Granek

Grabowski teaches a “fully automatic, self-contained and portable fire extinguishing apparatus which can be easily transported to and installed in an area wherein temporary fire protection is desired.” Grabowski at col. 1, lines 40-44. The device of Grabowski has a portable base housing and self-contained sources of electrical power and fire extinguishing fluid within the housing, allowing “operation of the suppressor in even remote locations.” Id. at col. 2, lines 26-29.

Granek teaches a fire protection apparatus “for installation in a building and intended for distributing fire-extinguishing fluid selectively from a central source” to rooms throughout the building. Granek at col. 1, lines 7-10. The device of Granek includes a “single conduit” having nozzles spaced along its length, which extends from the central fluid source and “through the various areas to be protected.” Id. at lines 57-67. The device further includes “smoke, heat, or other fire hazard detectors...arranged centrally within the rooms” of the building. Id. at col. 2, lines 1-3. The detectors communicate with a control system that selectively activates valves associated with the central fluid source to provide fluid to the appropriate conduit.

In the Office Action at pages 3, 5, and 6, it was asserted that “since both references are in the same field of invention,” the modification would be obvious. Applicants respectfully disagree.

One of ordinary skill in the art would not look to the permanently installed system of Granek to modify the portable device of Grabowski because (1) there is no reason to provide the portable device of Grabowski with the relatively complex and expensive elements of Granek, (2) such a modification would render the device of Grabowski

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

unsuitable for its intended purpose, and (3) such a modification would run counter to an explicit teaching in Grabowski.

First, one of ordinary skill in the art would not have had any suggestion or motivation to provide the device of Grabowski with the relatively complex and expensive elements of Granek. For example, the control circuit of Grabowski initiates the discharge of fluid from the self-contained fluid source in response to a signal from a detector. The detector is supported above the housing and is connected to the control circuit by an "elongated cord 40." Grabowski at col. 3, line 66 to col. 4, line 12. There is no reason to modify the device of Grabowski with the elements of Granek, including a detector having "a transmitter which emits a distinctive and individually encoded signal" and a control system having a "signal receiver and decoder...connected electrically...to a plurality of relays." Granek at col. 4, lines 30-56. In addition to having increased complexity and cost, such a system would be less reliable than one utilizing a simple wire connection between the detector and the control circuit.

Second, modifying the device of Grabowski as suggested in the Office Action would render the device unsuitable for its intended purpose. (See M.P.E.P. § 2143.01.) For example, the permanently installed detectors, control panel, water supply, and conduits of Granek would prevent the device of Grabowski from being used as a "portable fire extinguishing apparatus which can be easily transported to and installed in an area wherein temporary fire protection is desired." Grabowski at col. 1, lines 40-44.

Third, modifying the device of Grabowski as suggested in the Office Action would run counter to an explicit teaching in Grabowski. Grabowski identifies "various circumstances wherein temporary fire protection is desired," including

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

on aircraft, trailers, railroad cars, ships, etc., or in some instances to protect an existing installation in circumstances **wherein the incorporation of a permanent fire extinguishing system would prove economically unwarranted.**

Grabowski at col. 1, lines 20-27. (emphasis added.)

Grabowski, therefore, teaches away from a modification incorporating features of the permanent fire extinguishing system of Granek, as suggested in the Office Action.

Thus, the claim rejection is not based on a suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, as required by the M.P.E.P. Rather the rejection relies on hindsight reconstruction and the teaching of Applicants' own disclosure to find the required motivation.

Because there is no suggestion or motivation to modify the Grabowski reference with Granek, as required by M.P.E.P. § 2143, Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

2. The combined teachings of Grabowski and Granek fail to teach or suggest Applicants' claimed combination

Grabowski teaches a "fire protection system 11" including a "plurality of suppressor units 12 connected by...electrical cables 13." Grabowski at col. 3, lines 25-27. Each suppressor unit includes a "portable base housing 18," a "container tank 21" within the housing containing a fire extinguishing medium, a "hollow discharge tube 23" extending into the tank, and a "hollow extendible mast assembly 24" connected to the discharge tube and supporting a "discharge head 29." Id. at col. 3, lines 44-66 and Fig.

2. A "fire detector 32" supported on the discharge head is connected to a control circuit

in a "circuit housing 34 having a control and indicator panel 35." Id. at col. 3, line 66 to col. 4, line 12. "After detection of fire by the detector unit 32," the control circuit initiates the release of the fire extinguishing medium "above the protected area." Id. at col. 4, lines 38-58.

Grabowski fails to teach or suggest Applicants' combination recited in claims 1 and 43, including at least "a transmitter associated with the storage unit and configured to transmit a first signal upon detection of the fire condition," "at least one receiver configured to detect the first signal and configured to provide a second signal indicating detection of the fire condition," and "a fire suppression device configured to discharge a fire suppressant material into the storage unit upon detection of the fire condition."

For example, the device of Grabowski uses wire connections (e.g., cables and/or cords), not an arrangement utilizing a "transmitter" and a "receiver," as recited in claims 1 and 43. Further, none of the components of Grabowski are "associated with the storage unit," as claimed. In fact, Grabowski provides no teaching of any "storage unit."

Further, as discussed above, the device of Grabowski releases a fire extinguishing medium "above the protected area," and is not "configured to discharge a fire suppressant material into the storage unit," as claimed. For example, in the device of Grabowski, "[f]inal positioning of the discharge head 29 and detector unit 32 near the ceiling of the protected zone is accomplished by adjustment of the mast section 28." Grabowski at col. 4, lines 29-32. (emphasis added.) Further, according to Grabowski, it is "an important feature of the invention" to discharge the fire extinguishing medium "through the discharge head 29 that is positioned above the protected area." Id. at lines

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

38-41. (emphasis added.) Thus, the device of Grabowski discharges a substance near the ceiling of a room, not "into the storage unit," as claimed.

The above-mentioned shortcomings of Grabowski were at least partially acknowledged in the Office Action at pages 3 and 6.

Grabowski also fails to teach or suggest Applicants' combination recited in claims 18 and 52, including at least "a plurality of storage units for storing freight, the storage units being located at predetermined positions in the storage area," "a transmitter associated with each storage unit and configured to transmit a first signal upon detection of a fire condition," "at least one receiver configured to detect the first signal and configured to provide a second signal indicating detection of the fire condition," and "a fire suppression device configured to discharge a fire suppressant material into the storage unit."

For example, Grabowski provides no teaching of "storage units," "a transmitter," "at least one receiver," and a device "configured to discharge a fire suppressant material into the storage unit," as claimed. Moreover, by teaching discharge of the fire extinguishing medium above the protected area, as discussed above, Grabowski teaches away from Applicants' claimed combination.

Finally, Grabowski fails to teach or suggest Applicants' combination recited in claim 41, including at least, "a plurality of containers in the storage area, wherein each container includes a base and a cover having an opening," "a fire suppression device located inside each of the containers, the fire suppression device comprising...a transmitter that emits a first signal through the opening when the fire detection system releases the fire suppressant material."

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

The above-mentioned shortcomings of Grabowski were at least partially acknowledged in the Office Action at page 5, where it is stated "Grabowski et al. [is] not specific about wherein the fire suppression device [is] located inside the container." It was asserted, however, that Grabowski "stated that the suppression device unit is a self-contained unit (portable), therefore, it is easy to install in any available spaces of the container." Id. Applicants respectfully disagree.

As discussed above, the suppressor units of Grabowski include a mast that positions the discharge head "near the ceiling" and "above the protected area," not "inside each of the containers," as recited in claim 41. Accordingly, Grabowski teaches away from a fire suppression device "located inside each of the containers," as claimed.

Granek teaches a "multi-compartmental conduit 11 and 12, which [extends] from a common water-supply manifold 13 horizontally through the rooms of [an] apartment." Granek at col. 2, lines 35-37. The conduit has "[n]ozzles 14...connected at intervals along the conduit," the nozzles each being "directed into the interior of a different respective area or room of the apartment." Id. at lines 38-40. The device further includes "smoke, heat, or other fire hazard detectors...arranged centrally within the rooms" of the building. Id. at lines 1-3. The detectors communicate with a control system that selectively activates valves associated with the central fluid source to provide fluid to the appropriate conduit.

Granek fails to teach or suggest Applicants' combination recited in claims 1 and 43, including at least "a transmitter associated with the storage unit" and "a fire suppression device configured to discharge a fire suppressant material into the storage unit upon detection of the fire condition."

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Granek also fails to teach or suggest Applicants' combination recited in claims 18 and 52, including at least "a plurality of storage units for storing freight, the storage units being located at predetermined positions in the storage area," "a transmitter associated with each storage unit," and "a fire suppression device configured to discharge a fire suppressant material into the storage unit."

Finally, Granek fails to teach or suggest Applicants' combination recited in claim 41, including at least, "a plurality of containers in the storage area, wherein each container includes a base and a cover having an opening," "a fire suppression device located inside each of the containers, the fire suppression device comprising...a transmitter that emits a first signal through the opening when the fire detection system releases the fire suppressant material."

Thus, Granek fails to overcome the deficiencies of Grabowski identified above.

Because the combined teachings of Grabowski and Granek fail to teach or suggest Applicants' claimed combination recited in independent claims 1, 18, 41, 43, and 52, as required by M.P.E.P. § 2143, Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

B. Official Notice

Regarding the rejection of claims 8, 43, and 52, Applicants provide the following additional comments. It appears that the Examiner has taken Official Notice in making the statements bridging pages 3 and 4 and at page 7 relating to the interchangeability of radio signals and infrared signals. The Examiner is respectfully reminded of the provisions of M.P.E.P. § 2144.03. An Official Notice rejection is proper only in instances

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

where the facts asserted are well-known or common knowledge in the art and capable of instant and unquestionable demonstration as being well-known. Further, it is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principal evidence upon which a rejection is based. Accordingly, Applicants request that the Examiner either cite a competent prior art reference in substantiation of these conclusions, provide a personal affidavit, or withdraw the rejection.

C. Other Cited References

As discussed above, claims 1, 18, 41, 43, and 52 are patentable over Grabowski in view of Granek. Pappas, Sears, Eguchi, and Fierbaugh fail to overcome the above-noted deficiencies of Grabowski and Granek.

Applicants respectfully submit that claims 1, 18, 41, 43, and 52 are patentable over the references applied in the Office Action. Claims 2-17, 19-27, 42, 44-51, and 53-58 depend directly or indirectly from independent claims 1, 18, 41, 43, and 52 and therefore should be allowable for at least the same reasons the claims from which they depend are allowable.

VI. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 5, 2003

By: Christopher H. Kirkman
Christopher H. Kirkman
Reg. No. 46,223

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com